

DETAILED ACTION

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11-14, 19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Niwa et al. (US 5,213,112).

Regarding claims 11-12, and 19, Niwa et al. disclose a position locating instrument (figure 2) for accurately determining the location of a cutting plane, the instrument comprising a base (18, figure 2) connected to means (11, figure 2) capable of determining the position of the instrument, a plate (26, figure 2) moving along with the base for insertion into an opening (24, figure 2) of a bone cutting guide (19, figure 2), and resilient means (27, figure 2) for compensating for the play between the plate and the guide to prevent a movement of the instrument when it is inserted in the opening, the resilient means extending outwardly along only one face (first face, see figure below) of the plate to cause an opposite planar face of the base (see figure below) to lie flush against a complementary planar surface (see figure below) that defines the opening. Wherein the opposite planar face of the base (see figure below) comprises a surface (see figure below) provided to be maintained bearing against the complementary surface of the opening under the action of the flexible blades. The resilient play compensation means comprise at least three flexible blades (rack gears)

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provided to bear against a surface of the opening. The resilient play compensation means comprise at least one flexible, *i.e. capable of flexing*, blade provided to bear against a surface (see figure below) of the opening, and the flexible blades are parallel (figure 2).

Regarding claim 22, Niwa et al. disclose a system for accurately determining a location of a cutting plane to permit a bone cutting operation to be performed comprising a bone-cutting guide (19, figure 2) having an opening (see figure below) in which a cutting blade is inserted, the opening having a first surface (see figure below) and an opposing second surface (see figure below); and a position locating instrument (13, figure 2)) for accurately determining the location of the cutting plane, the instrument comprising a base (18, figure 2) connected to means (11, figure 2) capable of determining the position of the instrument, a plate moving along with the base for insertion into the opening of the bone cutting guide (19, figure 2)), the plate having a first face (see figure below) and an opposing second face (see figure below), and resilient means (27, figure 2) for compensating for the play between the plate and the guide to prevent a movement of the instrument when it is inserted in the opening of the bone cutting guide, the resilient means comprising a plurality of flexible, *i.e. capable of flexing*, blades extending outwardly along only the first face of the plate (see figure below) and bearing against the first surface (see figure below) of the opening to thereby accurately locate the cutting plane by maintaining the second face (see figure below) of the plate in contact against the second surface (see figure below) of the opening, wherein the second face is in contact against the second surface at a location of the

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plate where all of the blades are formed and are bearing against the opposite first surface (figure 3).

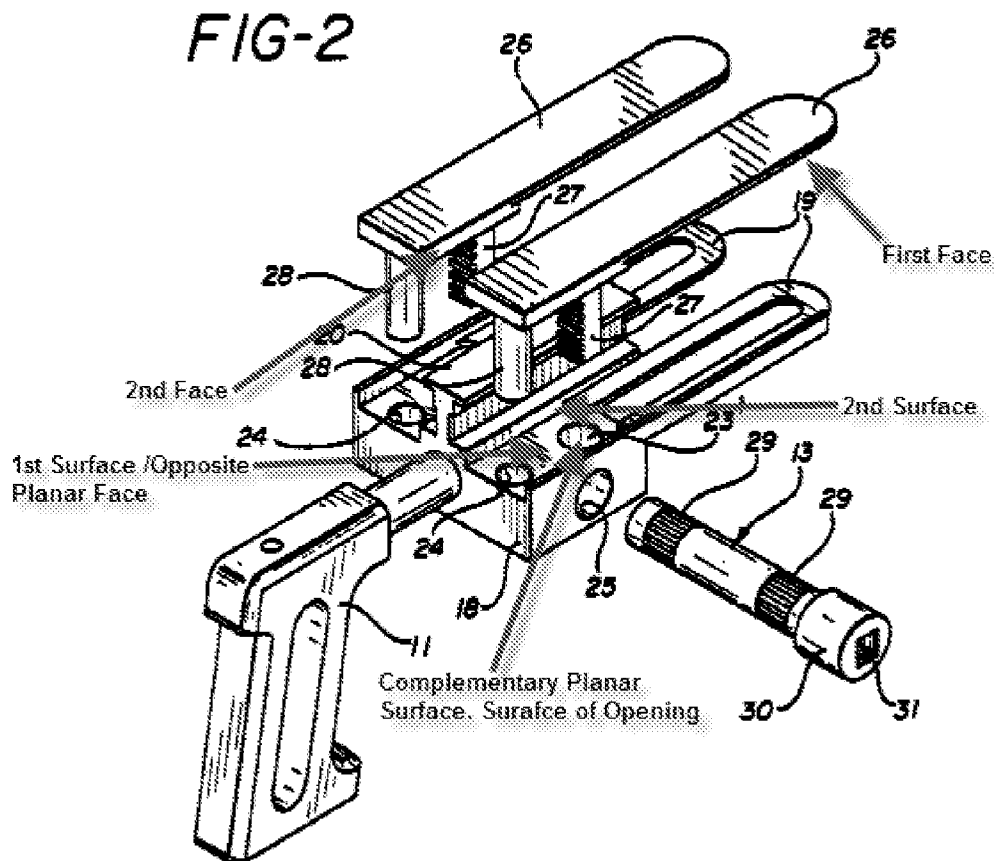
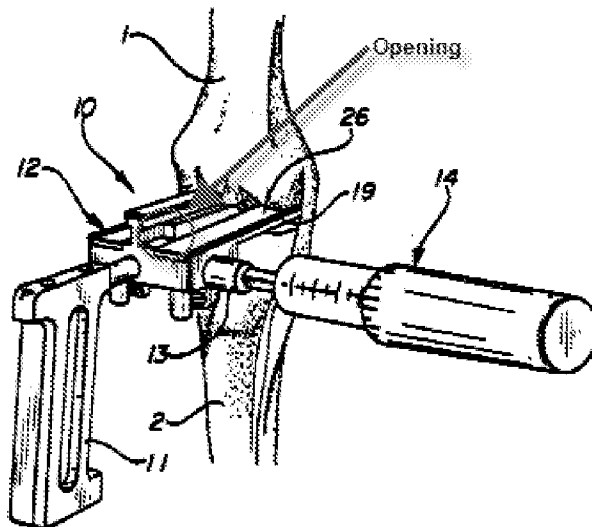


FIG-3



Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa et al. (US 5,213,112).

Niwa et al. do not explicitly disclose the plate being formed of a resilient material. The plates are required to be capable of withstanding and measuring the degree of tension between bones; therefore it is obvious that the device of Niwa must be made of a resilient material to be capable of withstanding the tension applied by placing the plate between the two bones to measure the exerted tension.

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7. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niwa et al. (US 5,213,112) in view of Neubauer et al. (US 2002/0068942).

Niwa et al. disclose the claimed invention except for the means capable of determining the position of the instrument being back-reflective disks and the locating instrument having markers capable of cooperating with means for locating the position of the marker.

Neubauer discloses means capable of determining the position of the instrument being back-reflective disks (22a-c, figure 1) and the locating instrument having markers capable of cooperating with means for locating the position of the marker (22a-c, figure 1, ¶28) to navigate and position the device (¶28, 33). Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the device of Niwa et al. to include markers as taught by Neubauer et al. to more accurately navigate and position the device.

Allowable Subject Matter

8. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments with respect to claims 11-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW LAWSON whose telephone number is (571)270-7375. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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